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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/697,907 | 10/29/2003 | Scott Malcolm Caplan | 35006-556F01US | 9741 |
| 22862 7590 11/13/2008 GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025 | | | | |
| EXAMINER BOYCE, ANDRE D | | | | |
| ART UNIT 3623 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,907

Applicant(s)

CAPLAN ET AL.

Examiner

Andre Boyce

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 55-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-08)
Paper No(s)/Mail Date 10/29/03, 4/6/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention I, claims 1-54, in the reply filed on July 23, 2008 is acknowledged. Claims 1-54 have been examined.

Specification

2. The abstract of the disclosure is objected to because it is longer than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 43 is objected to because of the following informalities: The claim depends from claim 90, however there are only 71 originally filed claims. For examination purposes, the Examiner will assume the claim depends from claim 28. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular

apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to independent claim 1, the claim language recites the step of "providing any of" a plurality of modules, wherein each of said modules has "capability" to interact with an expert task manager, however the claim language does not include the required tie or transformation. The modules are simply considered software, and "providing" the modules may simply require delivering them. In addition, the "capability to interact" is considered a nominal tie that does not satisfy the requirement (i.e., simply having the capability does not require interaction with an expert manager). Furthermore, the expert manager may also simply be deemed software.

Claims 2-27 are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection. See MPEP §2164.08(a).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 28 recite "...each of said modules has the *capability* to interact..." which is rendered vague and indefinite, since having the "capability" does not necessarily indicate that the modules actually interact with an expert task manager. Clarification is required. Claims 2-27 and 29-54 are rejected based upon the same rationale as dependent claims.

Claim 13 is rendered vague and indefinite for use of the phrase "modeled crudely." It is unclear what constitutes a driver being modeled crudely by one or two decision keys.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Gronau et al (US 2003/0069869).

As per claim 1, Gronau et al disclose an iterative method for creating and evaluating strategies (i.e., development of a strategic plan through execution of a sequence of steps, ¶ 0014), comprising the steps of: providing any of: a team development module for developing a strategy modeling team; a strategy situation analysis module for framing a decision situation (i.e., applying the computer aided strategic planning to preset rules and values to articulate a vision, develop goals in multiple domains and define objectives, ¶ 0020); a data request and reception module for designing and executing logistics of specifying, acquiring, and loading data required for decision and strategy modeling; a data transformation and cleansing module for verifying, cleansing, and transforming data; a decision key and intermediate variable creation module for computing additional variables from data and constructing a data dictionary; a data exploration module for determining characteristics that are effective decision keys and intermediate variables; a decision

model structuring module for formalizing relationships between decisions, decision keys, intermediate variables, and value of a decision model; a decision model quantification module for encoding information into a decision model; a strategy creation module for determining strategies that a client can test; and a strategy testing module for testing strategies to guide refinement of strategies and refinement of a decision model and to select a best strategy for deployment; wherein each of said modules has capability to interact with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes and sub-processes (i.e., computer aided strategic planning expert system uses knowledge an difference procedures of an expert strategic planner, ¶ 0054).

As per claims 2, 4-12, 14, 18-23, 25, and 27, independent claim 1 recites "providing any of." As a result, providing any one of the plurality of modules anticipates Applicant's claimed language. As seen above, with respect to claim 1, Gronau et al disclose, inter alia, a strategy situation analysis module for framing a decision situation. As a result, these dependent claims are moot, since they pertain to modules other than the strategy situation analysis module (i.e., modules not selected).

As per claim 3, Gronau et al disclose identifying the values of the organization; and ensuring that the right decisions and strategies are considered in an analysis (i.e., applying the computer aided strategic planning to preset rules and values to articulate a vision, develop goals in multiple domains and define objectives, ¶ 0020).

As per claim 13, Gronau et al disclose beginning with a simplified value model having less than eight drivers (i.e., applying the computer aided strategic planning to preset rules and values to 1) articulate a vision, 2) develop goals in multiple domains, 3) define objectives, 4) selection of strategies, and 5) identification of action items, ¶ 0020); wherein each of said drivers is modeled crudely by one or two decision keys (i.e., preset rules and drivers); initially including no constraints; using said simplified value model for beginning said strategy creation module and said strategy testing module, said strategy creation module and said strategy testing module indicating areas of said decision model where refinement adds particular value; and after interaction between said decision model and strategies is acceptable, iteratively adding details reflecting limitations of a business process (i.e., as new information is entered, the computer aided strategic planning program automatically updates the plan across domains, ¶ 0020).

As per claim 15, Gronau et al disclose providing a decision quality process for enabling an organization to systematically identify, understand, and track views of quality of decision making (i.e., computer aided strategic planning expert system uses knowledge and inference procedures to assist the user, including monitoring, control and instruction, ¶¶ 0054-0063).

As per claim 16, Gronau et al disclose providing any of six dimensions associated with any of six links in a decision quality chain, said any of six links comprising: appropriate frame; creative-feasible alternatives; meaningful-reliable information; clear values and tradeoffs; logically-correct reasoning; and commitment

to action (i.e., development of action plan, ¶ 0069); wherein said chain supports an organization's value (i.e., definition of values applied to the planning, ¶ 0068).

As per claim 17, Gronau et al disclose framing a problem by: identifying issues; developing a decision hierarchy; understanding an organization's values; and brainstorming and clarifying alternatives (i.e., development of a profile to define values, priorities, policies and rules, ¶ 0068); further understanding said organization's values by: developing value metrics and prototyping metric results (i.e., development of a profile to define values, priorities, policies and rules, which are added to the factory established rules and axioms, ¶ 0068); and planning for data acquisition by: identifying intermediate variables; and developing a plan for assessment (i.e., diagnosis and prescription, ¶¶ 0054-63); wherein for clarification: optionally returning to said framing a problem step after said further understanding said organization's values step; and optionally returning to said further understanding said organization's values step after said planning for data acquisition step (i.e., as new information is entered, the computer aided strategic planning program automatically updates the plan across domains, ¶ 0020).

As per claim 24, Gronau et al disclose the step of providing a score tuner component for automating decision model updating and reporting (i.e., as new information is entered, the computer aided strategic planning program automatically updates the plan across domains, ¶ 0020, including measurement and assessment and reports generation, ¶¶ 0030-31), said score tuner component comprising any of: data awareness capability; triggering rules (i.e., preset rules and values); model

history retention; self-guided model development; connection to a decision engine; and execution and analytic audit trails; wherein when a tuning run is triggered, results are reviewed and either accepted and an update is deployed, or rejected (i.e., as new information is entered, the computer aided strategic planning program automatically updates the plan across domains, ¶ 0020, based upon the preset rules and axioms).

As per claim 26, Gronau et al disclose providing a non-linear constrained optimization tool for improving test designs and optimizing strategies (i.e., computer aided strategic planning program, ¶ 0020).

Claims 28-54 are rejected based upon the same rationale as the rejections of claims 1-27, respectively, since they are the apparatus claims corresponding to the method claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Heyns et al (US 2004/0073442) disclose developing a strategic planning solution for a business organization.

-Flores (USPN 7346529) discloses an enterprise strategy management system.

-Zarb (US 2004/0039619) discloses analyzing an organization.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/
Primary Examiner, Art Unit 3623
October 30, 2008